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2006-1449
(SERIAL NO. 09/499,069)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE TED EUGENE WRIGHT

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK
OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES

REPLACEMENT BRIEF OF APPELLANT TED EUGENE WRIGHT

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August 26, 2006

1-PR

CERTIFICATE OF INTEREST

Counsel for the Appellant certifies the following:

1. The full name of every party or amicus represented by me is:

Ted Eugene Wright

2. The name of real party in interest represented by me is:

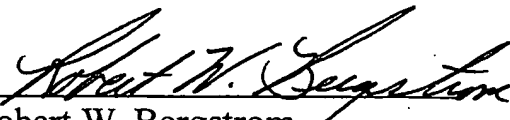
Electronic Forms Plus, Inc.

3. There are no corporations or any publicly held companies that own 10 percent or more of the stock of the party represented by me.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court:

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REQUEST FOR ORAL ARGUMENT

Appellant requests oral argument.

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STATEMENT OF RELATED CASES

Pursuant to Federal Circuit Rule 47.5, Appellant notes that continuation-in-part Patent Application No. 11/009,324 claims priority to the present application. There are no related cases under the jurisdiction of the Federal courts.

JURISDICTIONAL STATEMENT

The statutory basis for jurisdiction of the Board of Patent Appeals and Interferences is 35 U.S.C. §134.

The statutory basis for jurisdiction of this Court to hear this Appeal is 28 U.S.C. §1295(a)(4)(A).

The Appeal for review in this case is timely since it has been filed within the time provided in 35 U.S.C. §142 from the Decision of the Board of Patent Appeals and Interferences dated April 6, 2006.

ABBREVIATIONS AND RECORD REFERENCES

Ted Eugene Wright, owner of Electronic Forms Plus, Inc., is referred to as "Appellant." The United States Patent and Trademark Office is referred to as the "USPTO." The Board of Patent Appeals and Interferences of the USPTO is referred to as the "Board." U.S. Patent Application No. 09/499,069 is referred to as the "Current Application." U.S. Patent No. 3,655,119 is referred to as "Thompson." U.S. Patent No. 4,850,611 is referred to as "Skelton." U.S. Patent No. 4,592,573 is referred to as "Crowell." Citations to numbers of pages in the

Appendix are preceded by the letter "A" (e.g., A569). Citations to the Appendix may also include a description of the cited documents.

The Office Action dated October 11, 2000, is referred to as the "First Office Action." The Response filed on February 12, 2001, is referred to as the "First Response." The Office Action dated April 27, 2001, is referred to as the "Second Office Action." The Response filed on July 27, 2001, is referred to as the "Second Response." The Office Action dated October 9, 2001, is referred to as the "Third Office Action." The Amendment filed on January 9, 2002, is referred to as the "Third Response." The Office Action dated March 6, 2002, is referred to as the "Fourth Office Action." The Preliminary Amendment filed on August 5, 2002, is referred to as the "Fourth Response." The Office Action dated August 27, 2002, is referred to as the "Fifth Office Action." The Response filed on November 27, 2002, is referred to as the "Fifth Response." The Office Action dated February 21, 2003, is referred to as the "Sixth Office Action." The Amendment filed on May 23, 2003, is referred to as the "Sixth Response." The Supplemental Amendment filed on May 27, 2003, is referred to as the "Sixth Supplemental Response." The Amendment filed on July 17, 2003, is referred to as the "Sixth Resubmitted Response." The Office Action dated October 6, 2003, is referred to as the "Seventh Office Action." The Appeal Brief filed on March 5, 2004, is referred to as the "Appeal Brief." The Office Action dated June 4, 2004, is referred to as the

"Eighth Office Action." The Supplemental Appeal Brief filed on October 4, 2004, is referred to as the "Supplemental Appeal Brief." The Examiner's Answer, issued May 18, 2005, is referred to as the "Examiner's Answer." The Supplemental Reply Brief filed on May 18, 2005, is referred to as the "Supplemental Reply Brief." The Decision on Appeal issued April 6, 2006, is referred to as the "Decision on Appeal." Appellant apologizes for the lengthy list of abbreviations, but, of course, would have preferred a much shorter prosecution history.

STATEMENT OF THE ISSUES

Issue 1: Whether the Board erroneously concluded that claims 1-5, 7, and 11-21 are unpatentable, under 35 U.S.C. §103(a), over Thompson combined with either or both of Skelton and Crowell?

Issue 2: Whether the Board erroneously concluded that claims 1-7 and 11-21 are unpatentable under 35 U.S.C. §103(a) over the cited references despite Appellant's Declaration and submitted evidence of *Graham* secondary considerations, including commercial success?

STATEMENT OF THE CASE

Appellant filed Provisional Patent Application No. 60/135,136 with the USPTO on May 20, 1999. On February 4, 2000, Appellant filed the Current Application which claims benefit to Provisional Application No. 60/135,136. The originally filed application included ten claims. In the First Office Action, dated

October 11, 2000, the Examiner required restriction to one of group 1, claims 1-7 and group 2, claims 8-10. The claims of group 2 were later included in a divisional application, filed August 5, 2002, which issued as U.S. Patent No. 6,901,370. The Examiner made minor objections to the drawings, specification, and claim 1, rejected claim 7 under 35 U.S.C. §112, second paragraph, rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,734,396 ("Cowan") in view of U.S. Patent No. 5,141,485 ("Welt"), and rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Cowan and Welt in view of U.S. Patent No. 5,933,085 ("Holcomb"). In the First Response filed February 12, 2001, Appellant corrected the specification, drawings, and claims to overcome the Examiner's objections and 35 U.S.C. §112, second paragraph rejection. Appellant traversed the Examiner's rejections of claims 1-7 under 35 U.S.C. §103(a), arguing that the Examiner had failed to establish a *prima facie* case of obviousness. Appellant also argued that the claimed invention had enjoyed substantial commercial success, and was therefore not obvious under *Graham v. John Deere*, 383 U.S. 1 (1966).

In the Second Office Action, dated April 27, 2001, the Examiner rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and further in view of Thompson. The Examiner rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and

Thompson and further in view of Holcomb. In the Second Response, filed July 27, 2001, Appellant traversed the 35 U.S.C. §103(a) rejections of claims 1-7, again arguing that the Examiner had failed to establish a *prima facie* case of obviousness. Appellant again argued the secondary consideration of commercial success. In the Third Office Action, dated October 9, 2001, the Examiner rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and in further view of U.S. Patent No. 4,488,737 ("Jacobs"), and rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and in further view of U.S. Patent No. 5,303,956 ("Zoland"). In a brief telephone interview on January 9, 2002, the Examiner indicated that she was not disposed to allowing product claims in the current case, but suggested that Appellant might find success in pursuing method claims in a divisional application. In the Third Response, filed January 9, 2002, Appellant amended claim 1 and traversed the 35 U.S.C. §103(a) rejections, arguing that no combination of Cowan, Jacobs, or Skelton produces the elements of claim 1, and further arguing that the Examiner had failed to cite a motivation for the combination of cited references used by the Examiner in the rejections.

In the Fourth Office Action, dated March 6, 2002, the Examiner reiterated the 35 U.S.C. §103(a) rejections of the Third Office Action. Appellant filed a continuation application on August 5, 2002, along with a preliminary amendment

in which claims 11-15 were added, and in which a Declaration and four exhibits were submitted in support of the argument for non-obviousness in view of *Graham* secondary considerations. The exhibits included: (A) two fax advertisements for single-sheet registration form and key packets retailed by USFI Printers and Focus Services; (B) an email correspondence from an employee of Hilton Equipment Corporation, a subsidiary of the Hilton Hotels Corporation to which Appellant supplies single-sheet registration form and key packets, who was attempting to force Appellant to remove the "patent pending" notice and company identification from Appellant's single-sheet registration form and key packet product; (C) an exemplary two-ply registration form used prior to Appellant's invention of the single-sheet registration form and key packet; and (D) examples of the claimed single-sheet registration form and key packet. In the Declaration, Appellant revealed steady increases in sales of this single-sheet registration form and key packet over the years 2000 and 2001, and in the first five months of 2002, a statement attesting to the copying, manufacture, and retailing of the claimed single-sheet registration form and key packets by others following Appellant's invention and commercialization of the single-sheet registration form and key packet, a statement that Hilton Equipment Corporation attempted to force Appellant to remove the "patent pending" notice and company identification from Appellant's products in order to request bids from competitors, and a statement outlining

Appellant's conception and reduction to practice of the single-sheet registration form and key packet during the 1990's, and a relatively lengthy period of time, from 1988 to 1998, during which time Appellant observed the inefficiency of previous registration methods as Appellant worked to develop the claimed single-sheet registration form and key packet.

In the Fifth Office Action, dated August 27, 2002, the Examiner found the submitted Declaration insufficient based on M.P.E.P. §716, rejected claims 1-6 as being unpatentable under 35 U.S.C. §103(a) over Skelton in view of Cowan and further in view of Jacobs, rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Zoland, and rejected claims 11-15 under 35 U.S.C. §103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of U.S. Patent No. 6,299,401 ("Pacione"). In the Fifth Response, filed November 27, 2002, the Appellant argued that the Examiner's stated reasons for finding the Declaration insufficient made no sense in the current case, and resubmitted the Declaration and exhibits to clearly emphasize that the Declaration was directed to the commercial success and other considerations of Appellant's single-sheet registration form and key packet, and not to a chemical invention or any other type of device or procedure that included Appellant's single-sheet registration form and key packet

as a component. Appellant again argued that a combination of the cited references failed to disclose the elements of the rejected claims.

In the Sixth Office Action, dated February 21, 2003, the Examiner again found the amended Declaration to be insufficient under M.P.E.P. §716 and reiterated the 35 U.S.C. §103(a) rejections of claims 1-7 and 11-15 included in the Fifth Office Action. In the Sixth Resubmitted Response, filed July 17, 2003, Appellant added claims 16-21, again argued that the Examiner's finding of the Declaration as being insufficient made no sense, appeared to represent a fundamental misunderstanding of *Graham* secondary considerations, and was inconsistent with M.P.E.P. §716, argued that the Examiner's continued assertions that forms disclosed in the cited references are computer-printer compatible were entirely unfounded, and argued that the Examiner was employing hindsight recognition of Appellant's claimed invention in crafting the various multi-reference obviousness-type rejections, and submitted a second Declaration and four additional exhibits detailing the requirements for paper used in commercial-grade Hewlett-Packard laser printers, in support of limitations in claims 11 and 16.

In the Seventh Office Action dated January 6, 2004, the Examiner objected to claims 5 and 16, rejected claims 1 and 7 under 35 U.S.C. §102(b) as being anticipated by Thompson, rejected claims 2 and 5 under 35 U.S.C. §103(a) as being unpatentable over Thompson, and rejected claims 3, 4, and 11-21 under 35

U.S.C. §103(a) as being unpatentable over Thompson in view of Crowell. On January 5, 2004, Appellant filed a Notice of Appeal. On March 5, 2004, Appellant filed the Appeal Brief along with minor amendments to place the claims in the final form for the appeal. In the Eighth Office Action, issued on June 4, 2004, the Examiner re-opened prosecution and rejected claims 1-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Skelton and rejected the remaining claims under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Skelton and in further in view of Crowell. On October 4, 2004, Appellant filed the Supplemental Appeal Brief requesting the originally filed appeal to be reinstated. The Examiner issued the Examiner's Answer on May 18, 2005. The Examiner's Answer is based on the rejections offered in the Eighth Office Action, issued June 4, 2004, in which the Examiner had re-opened prosecution, rather than the rejections included in the Seventh Office Action with regard to which the appeal was originally filed. On May 18, 2005, Appellant filed the Reply Brief and the Supplemental Reply Brief in response to the Examiner's Answer, and on April 6, 2006, the Board issued the Decision on Appeal, affirming the Examiner's rejection under 35 U.S.C. §103(a) of claims 1-5 and 7 as being unpatentable over Thompson in view of Skelton and rejection of claims 11-21 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Skelton and Crowell. Appellant appeals the Decision on Appeal.

STATEMENT OF THE FACTS

I. Current Application

The invention claimed in the Current Application (A0043-63) is a single-sheet registration form and key packet that is used in hotels, motels, and other such businesses in which guests or customers are registered and provided with keys. The single-sheet registration form and key packet is preprinted with general information. At the time that a guest or customer is registered, a clerk may obtain registration information from the guest, type that information into a form displayed by a computer, and print the information, or a subset of the information, onto the single-sheet registration form and key packet via a laser printer or other printing device interconnected with the computer in order to produce a completed registration form and key packet. Following printing of the single-sheet registration form and key packet, the clerk, in one step, separates the registration form from the key packet along a line of perforations, and provides the registration form for the guest's signature. The clerk then quickly assembles the key packet in two steps by folding along two lines of perforations, inserts one or more room keys into slots dye-cut into the key packet, and hands the assembled key packet to the guest.

Figure 2 (A0056) shows a single-sheet-registration-form-and-key-packet blank, prior to initial printing. The single-sheet-registration-form-and-key-packet

blank includes a perforated, vertical fold line, a horizontal line of perforations 204 separating the registration form 206 from the key packet 208, a horizontal perforated fold line 210, and dye-cut slots 212 and 214 for holding a magnetic key card and metal key, respectively. Figure 3 (A0057) shows the single-sheet registration form and key packet following initial printing, commonly offset printing, to produce a preprinted single-sheet-registration-form-and-key-packet form. Preprinted single-sheet-registration-form-and-key-packet forms are loaded into a printer interconnected with a desk computer, and are printed with particular guest information and time-sensitive information, as shown in Figure 4 (A0058). The registration form is separated from the key packet, as shown in Figure 5 (A0059). The key packet is then folded along the horizontal, perforated fold line, as shown in Figure 6 (A0060), and then folded along the vertical, perforated fold line to produce the completed key packet, as shown in Figure 8 (A0062). Example preprinted single-sheet-registration-form-and-key-packet forms (A0382-83) were provided, in Exhibit D, in the Fourth Response.

II. Thompson

Thompson (A0016-19) discloses a ticket envelope manufactured by bonding a glassine sheet to an irregularly shaped piece of paper, folding a rear panel onto a front panel, folding a flap onto the folded rear panel and bonding the flap to the rear panel with adhesive, and then folding a closing panel onto the front-

panel/glassine/flap assembly. Thompson's ticket envelope is shown partially assembled in Figure 1 and shown in pre-assembly form in Figure 2 (A0017). As shown in Figure 2, the pre-assembly ticket envelope is a non-rectangular piece of paper with a protruding flap 20 and a pronounced, non-rectangular rear panel 16 protruding from a seemingly rectangular front panel 14 and closure panel 18. The pre-assembly ticket envelope includes "a sheet of material 44, such as glassine for example, of a generally rectangular configuration ... bonded to the inner face 24 of rear panel 16." (A0018, column 2, lines 37-39). "The separate pocket is formed by cutting a slot in the panel which comprises one face of the usual ticket pocket and bonding a sheet of material on the inner face of such panel to provide a pocket within a pocket panel," (A0018, column 1, lines 34-39). The protruding tab, or flap 20, is "adapted to be folded along fold line 36 into overlying relation with the bottom portion of the outer face of rear panel 16 when the latter has been folded against panel 14, and to be secured thereto by adhesive 38 to form a first pocket for receiving and retaining tickets therein." (A0018, column 2, lines 16-20). Thompson does not disclose the dimensions of the disclosed ticket envelope.

III. Skelton

Skelton (A0020-29) discloses a single-sheet ticket envelope, as shown in Figure 1 of Skelton. Skelton's ticket envelope includes a number of between 3 and 9 panels. (A0027, column 4, lines 65-67 and A0021, labels 24, 26, 28, 30, 32, 34,

36, 38, and 40 in Figure 1). Skelton's ticket envelope, when unfolded, is not rectangular, instead including a protruding flap 43 in all embodiments. Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel 43 would, in a three-panel embodiment, constitute fully 13% of the area of the three panels, and would represent an excursion of fully 37% in the width of the rectangle formed by the three panels. Skelton does not include die-cut slots, a detachable registration form, or a registration form and key packet. Nowhere in Skelton are the dimensions of Skelton's foldable container disclosed.

IV. Crowell

Crowell (A0030-38) discloses a folded stationery piece with a three-dimensional pop-up message displayed along an internal fold line. The Examiner apparently cites only a portion of one sentence in Crowell, the full sentence stating that "[a]nother object of the invention is to provide a foldable card or sheet which is conveniently inserted in and typed upon by a typewriter or computer printer and then quickly decorated with a separate pop-up three-dimensional message-bearing insert adhesively secured to the card or sheet along an internal fold line." (A0034, column 2, lines 46-51). In essence, Crowell indicates that is an object of Crowell's invention that a card or sheet be first printed or typed, and an insert then adhesively affixed to it. Crowell's alternative embodiments include non-rectangular sheets and sheets with dye-cut pop-outs, but the only embodiment deemed potentially

suitable for printing by Crowell is a card or sheet without the dye-cut pop-outs. Crowell does not again mention this object of the invention again, and thus it remains a stated goal, rather than an affirmative statement of whether or not the goal is met, by what considerations the goal may be deemed to have been met, the steps or processes for achieving the stated goal, or any constraints or problems encountered in, and overcome during, attempting to achieve the goal. Moreover, there is no indication of the dimensions or shape of an embodiment that might meet the stated object.

SUMMARY OF THE ARGUMENT

The primary reference used by the Examiner in the 35 U.S.C. §103(a) rejections of claims 1-5, 7, and 11-21 of the Current Application, Thompson, does not teach, disclose, mention, or suggest even a single element of independent claims 1, 11, and 16 of the Current Application. No combination of Thompson with either or both of the cited references Skelton and Crowell discloses, teaches, mentions, or suggests even a single element of the independent claims of the Current Application. The Examiner has failed to establish a *prima facie* case of obviousness.

Although Appellant has repeatedly demonstrated that no *prima facie* case of obviousness has been established, the Appellant has additionally furnished a Declaration attesting to, and evidence supporting, *Graham* secondary

considerations of non-obviousness. The Examiner has repeatedly dismissed the Declaration and evidence as being insufficient. However, these dismissals were generally unsupported by case law, statute, or rules, or cited irrelevant rules, and appear to be completely unfounded and arbitrary. In the Decision on Appeal, the Board offers a number of new justifications for concluding that the Declaration and submitted evidence are insufficient to demonstrate commercial success and copying by others. The conclusion is unjustified. Moreover, neither the Examiner nor the Board has provided any direction as to how Appellant can possibly satisfy the Examiner's and Board's seemingly arbitrary determinations of insufficiency. At this late stage of prosecution, Appellant still has no clear idea as to what Declaration and evidence to provide, and cannot be reasonably expected to have any chance of successfully responding. The failure by the USPTO to properly consider the Declaration and evidence submitted by Appellant, to provide direction as to how the Appellant can show commercial success and copying by others, and therefore to provide a reasonable opportunity for Appellant to successfully respond to the rejections is unreasonable and arbitrary, and constitutes a clear abuse of discretion.

Appellant is an individual inventor and small business owner with limited resources. Appellant has spent years of time and effort in developing the claimed invention, and has since created a successful business manufacturing and selling

his invention. The invention is quite straightforward, and easily comprehended, not only by those without technical and scientific backgrounds, but by anyone even cursorily familiar with paper and printers. Appellant is exemplary of the type of individual for whom the patent system was originally devised – namely, an inventor with limited resources needing a reasonable time window in which to exploit his invention.

Prosecution of the Current Application has spanned over six years, eight Office Actions, six Responses, the Appeal Brief, the Examiner's Answer, the Supplemental Reply Brief, and ten of thousands of dollars in legal expenses and fees. During this entire time, no credible rejection based on cited references has been offered, and only in the Decision on Appeal, after more than five years, has the USPTO provided an intelligible, although unfounded, justification for rejecting Appellant's Declaration and submitted evidence in support of *Graham* secondary considerations. Moreover, in the Decision on Appeal, the Board has: (1) failed to respond to many of Appellant's arguments; (2) misrepresented cited references; (3) misinterpreted and misconstrued the claims; (4) made incorrect statements and observations that would appear to indicate that no one on the Board has actually read the Current Application, the prosecution history, or the cited references; and (5) even taken a portion of a sentence of the Current Application out of the context

of the entire sentence, and the paragraph in which the sentence occurs, in order to misrepresent the teaching of the Current Application.

Appellant is left to wonder whether the USPTO fairly examines, and fairly adjudicates disputes related to examination of, patent applications directed to simple inventions filed by small inventors, or whether the entire process has been instead turned on its head, and serves only the interests of large organizations with resources to navigate the convoluted, irrational, and arbitrary landscape of patent-application prosecution. At the very least, after spending years of time and tens of thousands of dollars in legal expenses and fees, Appellant should be able to expect someone at the USPTO to take the time and effort to at least carefully review the record, attempt to fairly construe the claims and all of the claim limitations, and to fairly and conscientiously respond to Appellant's arguments.

ARGUMENTS

I. Standard Of Review

The Board's affirmation of the Examiner's obviousness-type rejections of claims 1-5, 7, and 11-21 are legal conclusions based on underlying factual determinations which are reviewed by the Court of Appeals for the Federal Circuit without deference. *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001). However, the underlying factual findings, and actions of the Board that are alleged to be arbitrary, capricious, an abuse of discretion, or otherwise not in accordance

with law, are reviewed by the Court of Appeals for the Federal Circuit to determine whether or not the factual findings are supported by substantial evidence. *In re McDaniel*, 293 F.3d 1379, 1382 (Fed. Cir. 2002). The Board's interpretation of USPTO regulations are accepted unless the interpretation is "plainly erroneous or inconsistent with the regulation." *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266 (Fed. Cir. 2003) "An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Id.*, 1266-7.

II. Issue 1

A. Thompson's Unfolded Ticket Envelope Is Decidedly Not Rectangular.

In the Decision on Appeal, the Board summarized the Examiner's analysis of Thompson, and then states "the Examiner finds that Thompson discloses all the claim limitations except for the score lines being perforations as required by the claims on appeal . . . We agree." (A0004-5).

However, in the next paragraph, the Board states:

With regard to the language used in claim 1 on appeal, we construe the claim as including at least a rectangular, single-sheet blank where one portion of the blank is designated a "registration form," and that portion is separated from another portion of the blank (designated the "key packet") by a line of perforations. (A0005-6)

Thus, the Board appears to recognize that "rectangular" is a claim limitation of claim 1, despite agreeing with the Examiner's analysis of Thompson in which the claim limitation "rectangular" is not mentioned. The Board then addresses arguments provided by Appellant in the Appeal Brief and Supplemental Reply Brief with regard to the non-rectangular nature of Thompson as follows:

Merely changing the shape of a paper form does not render the claimed form patentable, absent some showing of criticality. *See In re Dailey*, 375 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966). Appellant does not allege, much less show, any criticality for the shape of the registration form.⁴ We note that independent claim 11 on appeal does not require any particular shape for the single-sheet registration form and key packet. (A0006-7)

⁴To the contrary, appellant's specification teaches that the single-sheet registration form "may have any number of different shapes." (A0007)

First, Appellant would like to establish that Thompson's unfolded ticket envelope, shown in Figure 2 of Thompson, is not rectangular. As noted by the Board, claim 1 "is directed to the 'unfolded' product which merely has the *capability* of being folded to form a complete key packet and registration form." (A0006). Presumably, the Board acknowledges that claim 1 should be read on the unfolded ticket envelope of Thompson. As repeatedly noted by Appellant throughout the prosecution of the Current Application, Thompson's unfolded ticket envelope, shown in Figure 2 (A0017), is decidedly not rectangular. The ticket envelope includes a front panel 14 and a closure panel 18 which are joined at a fold line 40 and which together appear to be rectangular in shape. However,

Thompson's unfolded ticket envelope also includes a bottom flap 20 and a rear panel 16 that protrude from the left edge of the front panel and the bottom edge of the front panel, respectively, in Figure 2. The outer perimeter of Thompson's unfolded ticket envelope includes ten vertices joined by ten edges. By contrast, rectangles have four vertices joined by four edges.

Second, the Board completely mischaracterizes *In re Dailey* by citing *In re Dailey* as standing for the proposition that merely changing the shape of a paper form does not render the claimed form patentable, absent some showing of criticality. *In re Dailey* is neither concerned with, nor even once mentions, paper forms, but is instead concerned with an appeal for rejection of claims to a nursing container. There is no statement in *In re Dailey* related to rendering a claimed paper form patentable by changing the shape of the paper form, and no instance of the word "criticality" in *In re Dailey*. Instead, the Court in *In re Dailey* states:

Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. (*In re Dailey*, 357 F.2d 669, 672-673, 149 USPQ 47, 50 (CCPA 1966))

The Court is merely stating that, absent a showing that the configuration of a container is significant, the Court does not conclude that the particular configuration distinguishes the Appellants' nursing container from a prior-art nursing container. While it is not surprising to encounter citations to case law in

Office Actions that mischaracterize and misrepresent the holdings in the cases, it is surprising that the Board would so carelessly mischaracterize *In re Dailey*. While it is convenient to fabricate case law to support legal conclusions, even first-year law students learn that fabrication of case law is unacceptable in legal arguments.

Third, the Board's assertion that Appellant has not alleged, much less shown, any criticality for the shape of the registration form, in addition to being directed to a fabricated case-law requirement, is completely untrue, and reveals that the Board did not undertake even a cursory review of the prosecution history of the Current Application. Appellant notes that the Board explicitly states that the Board affirms both rejections on appeal based "on the totality of the record." (A0003-4). Had the Board reviewed the record, the Board would have found the following arguments as to the *significance* of a rectangular shape:

Finally, like Skelton's ticket envelope, Cowan's unfolded ticket envelope is not rectangular, but includes several asymmetrical flaps (16, 20, and 22 in Figure 2) *that would prevent feeding of the unfolded ticket envelope through a laser printer*. (A0401, Third Response, page 4, lines 1-3) (emphasis added)

From Applicant's representative's experience, rectangular paper having even small departures in dimensions from standard paper sizes can cause laser printers to malfunction, let alone a relatively large protruding flap. Nowhere in Skelton are the dimensions of Skelton's foldable container disclosed. Even were Skelton's unfolded foldable container actually rectangular, which it is not, there can be no certainty that it would be able to be fed through a laser printer without frequent jamming, or at least infrequent jamming at levels unacceptable in commercial environments. But, with a flap of relatively large area protruding from the bottom of the foldable

container, it is quite probable that the foldable container could not be used in laser-printer-based applications. (A0365, Fourth Response, page 6, lines 10-26)

Applicant provides, as an enclosure, a Declaration and exhibits that detail interactions with a major client regarding certain of the many parameters that need to be considered for producing a single-sheet registration form and key packet that can be printed in a commercially available computer printer. *As will hopefully be appreciated by the Examiner, producing such a form is not simply selecting dimensions and shape, although those considerations are quite important, but also involves many other considerations.* (A0220, Resubmitted Sixth Response, page 8, lines 1-28) (emphasis added)

Indeed, once folded, the folded form would be rectangular – but folded forms cannot generally be printed in computer printers. Even the thickness of single-sheet forms must be carefully controlled to allow for printing in a computer printer, as shown in materials provided as exhibits, and discussed in the following paragraph, but folded forms cannot be reliably oriented and printed in a computer printer. The single-sheet registration form and key packet includes die-cut slots and perforations for example, with critical tolerances for compatibility with a printer, and folding the single-sheet registration form and key packet prior to printing would vastly compound the problems attendant with meeting these tolerances. Whether or not the Examiner's proposed embodiment is rectangular *after folding* is therefore quite immaterial. *The Examiner's proposed embodiment is not rectangular when unfolded, and therefore is not suitable for printing in a computer printer in unfolded form.* (A0219-20, Resubmitted Sixth Response, page 7, line 26 - page 8, line 6) (emphasis added)

Thus, the claimed rectangular shape is significant, as repeatedly argued by the Appellant, because the single-sheet registration form and key packet needs to be printed on a commercially available computer printer or laser printer. The fact

that the single-sheet registration form and key packet is meant to be printed on a laser printer is discussed in the current application as follows:

The present invention relates to registration form signed by, and key packets provided to, registrars during a registration process and, in particular, to a single-sheet registration form and key packet that can be automatically printed by a laser printer or other automated printing device. (A0043)

One embodiment of the present invention provides a single-sheet registration form and key packet that can be printed on a general-purpose laser printer by a hotel, motel or other commercial organization during a registration process. (A0045)

The single-sheet registration form and key packets are typically loaded into a dedicated tray within a laser printer or other automated printing device. The hotel clerk may initiate printing of the single-sheet registration form and key packet by keying a command to the keyboard or inputting the command to a touch screen connected to the computer system. The registration software transmits the command to the laser printer, including particular guest information to be printed and software templates or references to already-loaded software templates that together comprise all the information needed by the laser printer to print a single-sheet registration form and key packet, as shown in Figure 4. (A0048-49) (emphasis added)

Fourth, Appellant would have expected the Board to know that independent claims stand on their own, and do not refer to other claims in the patent. *Lampi, LLC v. American Power Products, Inc.*, 65 F.Supp2d 757, 761 (N.D. Ill. 1999), *aff'd in part, vacated in part & remanded*, 228 F.3d 1365, 56 USPQ2d 1445 (Fed. Cir. 2000). The Board's attempt to interpret independent claim 1 based on a lack of the limitation "rectangular" in independent claim 11 represents a legal error in claim construction. The statement is also false, since claim 11 specifically

includes the limitation "a single sheet dimensioned to feed through a commercially available computer printer" which is closely related to the limitation "rectangular."

Fifth, the fourth footnote in which the Board claims that "Appellant's specification teaches that the single-sheet registration form 'may have any number of different shapes'" is a blatant misrepresentation of the teachings of the Current Application. Although one occasionally encounters quoted sentences taken out of context to bolster arguments in moot-court briefs and law-school-student memos, it is rather disturbing to see, in the Decision on Appeal, a portion of a single statement of an application taken out of context of both the statement as a whole, the paragraph in which the statement occurs, and the entire application. The paragraph in which the portion of the statement referred to by the Board occurs is provided below:

Although the present invention has been described in terms of a particular embodiment, it is not intended that the invention be limited to this embodiment. Modifications within the spirit of the invention will be apparent to those skilled in the art. For example, different sizes of single-sheet registration form and key packets may be used, *depending on the needs and desires of the registering organization and on the capabilities of laser printers or other automated printing devices.* In alternative embodiments, different types of pre-printed information may be employed, and relatively static information may be either pre-printed, generated from stored software templates, or provided by a combination of both techniques. Different numbers and orientations of perforation lines may be used to construct registration forms and key packets of different shapes and dimensions. *In the above example, the single-sheet registration form and key packet is rectangular, but, in alternative embodiments, the single-sheet*

registration form and key packet may be square, or may have any number of different shapes. (A0049-50)

The whole statement suggests alternate shapes for the single-sheet registration form and key packet. One alternative shape explicitly mentioned is a square. The statement mentions that there are many other possible shapes. However, the statement does not, as suggested by the Board, stand for the proposition that the single-sheet key packet and registration form can have any shape, and that shape is insignificant. Read in the context of the paragraph, the portion of the last sentence cannot be interpreted, for example, to suggest a shape that would produce a single-sheet registration form and key packet that could not be printed on a commercial laser printer or computer printer.

As those sufficiently unfortunate to need to interface with laser printers and computer printers well understand, laser printers and computer printers normally have rectangular feed trays in which rectangular paper is loaded for printing. The rectangular trays generally have two vertical, parallel sides that hold the longer edges of paper sheets in a stack of paper sheets in alignment with a feed roller which mechanically feeds a single sheet of paper from the top of the stack of paper into the printer. As well understood by those who use computer printers and laser printers, the paper loaded into the tray must generally have, at the least, two straight, parallel edges along the full length of the paper to interface with the two vertical sides of the rectangular tray. Otherwise, as the paper is being fed into the

printer, torsional forces usually cause the paper to rotate out of alignment with the printer mechanism, causing the paper to become skewed and generally causing annoying and time-consuming paper jams. Moreover, the leading edge of the paper fed into the computer printer or laser printer cannot depart greatly from a straight edge perpendicular to the parallel edges aligned with the vertical sides of the paper tray; otherwise, the paper will not engage uniformly with the feed rollers and may become unaligned with the printer mechanism. However, the distal edge of the paper may have any number of curved shapes, from a mathematical perspective in which infinitesimally small changes in the shape of the curve are possible, and remain compatible with laser printing or computer printing. For example, a slightly convex or concave curve, rather than a straight edge, would be compatible with the feed mechanisms of common printers, and there are, from a mathematical perspective, an infinite number of such slightly convex or concave curves. But, flaps protruding from an edge of both sets of parallel edges of a form effectively prevent the doubly-flapped form from being printable on a common laser printer or computer printer.

There are many ways to attempt to claim a single-sheet registration form and key packet intended for printing on a laser printer. Appellant chose, in claim 1, to claim rectangular single-sheet registration form and key packets as a useful subset of the possible single-sheet registration form and key packets that are printable by

commercially available laser printers and computer printers. Probably over 99% of papers printed on computer printers and laser printers are, in fact, rectangular, as can easily be verified by those who interact with such devices in office environments. In independent claims 11 and 16, discussed below, Appellant uses a different claiming strategy to claim computer-printable single-sheet registration form and key packets compatible with computer printers and laser printers.

As discussed above, the Board's attempt to contrast claim 11 with claim 1 in justification of dismissing the claim element "rectangular" is clear legal error. It is also quite misleading. Claim 1 and claim 11 have almost identical elements, except that claim 1 claims a rectangular, single-sheet registration form and key packet while claim 11 claims a single-sheet registration form and key packet comprising a single-sheet dimensioned to feature a commercially available computer printer. In other words, both claims are directed to the same invention, and claim the computer-printable feature of the single-sheet registration form and key packet in different ways.

B. Thompson's Unfolded Ticket Envelope is Not a Single Sheet.

The Board states that "Thompson clearly discloses a 'single-sheet' form (unitary blank 12; *See* Figure 2)." (A0009). Thompson does not disclose a single-sheet form. As noted in the Second Response:

Thompson is not a single-sheet ticket envelope, but is manufactured from separate pieces, including a die-cut blank (12 in Figure 2) and a

sheet of material such as glassine (Thompson, 44 in Figure 2 and column 1, lines 63-69 and column 2, lines 37-38). (A0418-9, Second Response, page 3, lines 31 - page 4, line 2).

As well described in the previous section, Appellant's single-sheet registration form and key packet is intended for printing on a commercially available laser printer or computer printer. As Appellant has repeatedly argued throughout the prosecution of the Current Application, and as the Appellant has asserted in a Declaration and accompanying exhibits (A0224-33), submitted with the Resubmitted Sixth Response, that describe paper thickness, paper characteristics, and other dimensions are critical for the paper to be successfully used in Hewlett-Packard laser printers. Similar requirements apply for other types of laser printers and computer printers. The claim limitation 'single-sheet' is directed, along with the other above-noted claim limitations, to ensure that the claimed single-sheet registration form and key packet can be printed on commercially available laser printers and computer printers.

Thompson's unfolded ticket envelope is not a single sheet, as expressly stated by Thompson and as expressly illustrated by Thompson. Thompson provides absolutely no information concerning the dimension characteristics of Thompson's unfolded ticket envelope. However, in view of the detailed exhibits and Declaration provided by Appellant, it can be confidently assumed that Thompson's unfolded ticket envelope, comprising two sheets of dissimilar material

bonded together, would probably not meet the requirements and standards promulgated by Hewlett-Packard, and, were the bonding to partially fail, would almost certainly lead to paper jams and even to printer damage.

C. There is No Basis to Conclude That Thompson's Unfolded Ticket Envelope is Dimensioned to Feed Through A Commercially Available Computer Printer, or That Thompson's Unfolded Ticket Envelope is A Single Sheet Having Dimensions, A Weight, A Texture, and A Moisture Content That Allows the Single Sheet to Be Reliably Fed Through A Commercially Available Computer Laser Printer.

As discussed above, Appellant has taken a different approach to claiming the single-sheet registration form and key packet in claims 11 and 16. In Claim 11, Appellant claims "a single-sheet dimension to feed through a commercially available computer printer," and, in claim 16, Appellant claims "a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be reliably fed through a commercially available computer laser printer." Appellant provided, in the Sixth Resubmitted Response, a Declaration and evidence to justify these claim limitations:

Applicant provides, as an enclosure, a declaration and exhibits that detail interactions with a major client regarding certain of the many parameters that need to be considered for producing a single-sheet registration form and key packet that can be printed in a commercially available computer printer. As will hopefully be appreciated by the Examiner, producing such a form is not simply selecting dimensions and shape, although those considerations are quite important, but also involve many other considerations. Newly added claims 16-21 are directed to even more clearly claiming the single-sheet registration form and key packet in this regard. (A0220, Sixth Resubmitted Response, page 12, lines 9 -16)

Thompson does not once teach, mention, disclose, or suggest dimensions, moisture content, weight, texture, or any other characteristics of Thompson's unfolded ticket envelope. As discussed above, because Thompson's unfolded ticket envelope has a very irregular shape, it can almost certainly be concluded to not be printable on a computer printer or laser printer. There is simply no basis for the Examiner or the Board to conclude that the claim limitations quoted above in claim 11 and 16 are taught or suggested by Thompson. Interestingly, neither the Examiner, in the Examiner's answer, nor the Board, in the Decision on Appeal, mentioned or addressed these claim limitations.

D. Thompson's Unfolded Single-sheet Ticket-Envelope Blank Cannot Be Accurately Folded Into a Complete Key Packet in Two or Fewer Steps.

In the Examiner's reply, the Examiner states that Thompson discloses a ticket envelope with an unfolded packet "including at most two score lines (30 and 36) that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps." (A0123). The Board concluded that "Thompson also clearly discloses a corresponding number of score lines 30, 36, and 40 (instead of the claimed perforations), with a unitary blank where the packet (for holding baggage claim tickets or travel tickets) is capable of being folded into a complete packet in 'two or fewer steps' as required by the claims on appeal." (A0009).

Both the Examiner and the Board fail to appreciate, despite Appellant's repeated arguments, that Thompson's unfolded ticket envelope requires more than two steps for manufacture. Thompson's unfolded ticket envelope not only includes three score lines, but also includes a separate sheet of glassine material (A0017, 44 in Figure 2 of Thompson) that needs to be bonded to the rear panel 16 as well as adhesive 38 that needs to be applied to the bottom flap 20 in order to manufacture Thompson's completed ticket envelope. A feature of Applicant's claimed invention is that the unfolded key packet, once separated from the registration form, can be quickly and accurately folded into a complete key packet in two or fewer steps. By contrast, a single-sheet blank including the front panel, rear panel, closure panel, and bottom flap of Thompson's ticket envelope cannot be folded into a completed key packet in two or fewer steps. Instead, a glassine sheet needs to be first bonded to the rear panel, and adhesive needs to be applied to the bottom panel. Both the Examiner and the Board erred in finding that a single-sheet ticket-envelope blank that might be used by Thompson to create the unfolded ticket envelope shown in Figure 2 of Thompson can be folded into a completed ticket envelope in two steps.

Furthermore, the score lines 30, 36, and 40 identified by the Board in Thompson's unfolded ticket packet are all intended to serve as fold lines. Thompson explicitly states that all three score lines are intended as fold lines, in

the paragraphs beginning on lines 10 and 27 of column 2, respectively. In particular, Thompson states, beginning on line 27 of column 2:

Closure panel 18 generally corresponds in shape and size to front panel 14 and is joined thereto along a score or fold line 40 defining the opposite side edge of panel 14 and generally parallel to fold line 30. Closure panel 18 is adapted to be bent along fold line 40 into a closed position overlying the pocket formed between front panel 14 and rear panel 16. (A0018)

Thus, Thompson includes three score lines to be used as fold lines, and that three fold operations are needed to construct Thompson's completed ticket envelope after the glassine sheet had been bonded to the die-cut blank and adhesive applied to the bottom flap. Considering only folding operations, Thompson's ticket envelope cannot be constructed in two or fewer steps.

E. There Is No Basis to Conclude That Thompson's Die-Cut Slot May Serve As a Slot or Slots to Hold a Number of Keys.

The Board states:

Appellant provides no reasoning or support for the conclusion that the packet taught by Thompson would not be "sufficiently stiff or proper in dimension" for holding metallic keys or key cards (Reply Brief, numbered page 16). *See In re Scarborough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) (generally held that attorney argument is not sufficient to replace evidence or expert testimony). We note that the slot 42 disclosed by Thompson is exemplified as holding a baggage claim ticket (52) (*See* Figure 1), as well as being capable of holding travel tickets (Column.1, 11.4-6). Claim 1 on appeal merely requires that "one or more die-cuts" must be capable of serving "as a slot . . . to hold a number of keys," and the type of key is not recited. Applicant has not set forth any reasoning why the slot 52 of Thompson would not be capable of holding a number of keys, whether the keys are metal or paper. (A0008-9)

First, had the Board reviewed the prosecution history, the Board would have discovered that Appellant has, in fact, set forth reasoning why the slot of Thompson would not be capable of holding a number of keys. Had the Board read Thompson, the Board would have discovered that Thompson does not teach, mention, or even suggest that Thompson's elongated opening or slot 42 is capable of holding any object. Furthermore, it is the Examiner's burden to demonstrate that Thompson teaches or suggests "one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet." *In re Bell*, 991 F.2d 781, 783 26 USPQ2d 1529 (Fed. Cir. 1993). The Board's attempt to shift the burden to Appellant is a clear legal error. In the Second Response, Appellant argued:

Both Skelton and Cowan completely lack "one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys in the complete key packet." The Examiner employs Thompson for disclosure of a key-containing slot, stating: "Thompson discloses an envelope having a slot (42) which is capable of retaining a key, key card, ticket, or the like" (Office Action, page 3, line 16). However, Thompson neither teaches, mentions, nor suggests retention of keys in the slot cited by the Examiner. Significantly, the elongated opening or slot 42 is an opening into a second pocket formed between rear panel 16 and the sheet of material 44 (Thompson, column 2, lines 33-39). Thompson's second pocket is designed to hold a boarding pass within the second pocket: "*Thus, a separate pocket is provided within a ticket pocket for the reception and retention of baggage claim checks or other accessory stubs*" (Thompson, column 2, lines 72-74, emphasis added). Thompson's elongated opening or slot does not hold the boarding pass, but merely serves as an opening into a manufactured pocket, which holds the boarding pass. Therefore, not only does Thompson fail to disclose, teach, mention, or suggest die-

cut slots, which serve to hold various types of keys within a key packet, Thompson's elongated opening and second pocket are structurally dissimilar from Applicant's die-cut key-holding slots. The dimensions of the elongated slot and of a boarding pass are not specified in Thompson. *There is therefore no basis for the Examiner to conclude that Thompson's slot is capable of retaining a key. It was neither designed to retain a key, nor designed to retain anything else.* (A0419, Response 2, page 4, lines 2-20)

Appellant also well described Thompson's disclosed ticket-holding pocket in the Appeal Brief and Reply. Thompson explicitly states, on lines 44 and 45 of column 2, that "slot 42 constitutes the mouth or inlet of the second pocket." (A0018). Thompson does not once teach, mention, or suggest that the elongated opening is intended to hold a key or any other object. In fact, were it capable of holding an object, then it would probably be either difficult or impossible to force the object through the elongated opening into the second pocket, in which the object is meant to be retained. Anyone familiar with paper and keys can immediately recognize the difference between Appellant's die-cut *slots* meant to hold objects (e.g. A0063, slot 212 in Figure 9) and the *elongated opening* or *aperture* 42 shown in Figures 1 and 2 of Thompson (A0017) that are not designed to hold a key or anything else, but are instead designed as an entryway to the second pocket. While it may be convenient for the Examiner and Board to conveniently ascribe characteristics and capabilities to features that they observe in patent illustrations, it is manifestly improper for them to do so. The cited

reference, not the examiner, must teach or suggest the claim limitations. See M.P.E.P. § 2143.

F. None of the Cited References Teach, Mention, or Suggest a Registration Form.

Fourth, in the Reply Brief and in the Board's decision, the Examiner and the Board concluded, without analysis, that Thompson discloses a ticket envelope including a registration form. However, none of Thompson, Skelton, and Crowell teaches, mentions, or suggests any kind of registration form. The term "registration form" cannot be found in these references. The Examiner points to numeric label 26 in Figure 2 of Thompson (A0017) which is, as expressly stated by Thompson in the paragraph of column 1 beginning on line 59, the inner face of the closure panel 18. (A0018). There is no indication in Thompson that closure panel 18 is intended to be anything other than a cover for a ticket envelope. In the Seventh Office Action, the Examiner argues, on lines 18-25 of page 3 (A0203), that:

Thompson discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a pre-printed registration form and key packet since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulak* 217 USPQ 401, (CAFC 1983).

However, in *In re Gulak*, the Court stated:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under Section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. (*In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (CAFC 1983))

In fact, in *In re Gulak*, the Court did find a functional relationship between printed matter substrate, stating:

Similarly, in examining Gulak's invention, we find that a functional relationship does exist between the printed matter and the substrate. A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about the substrate – is not required. *What is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability. The mere presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. (Id., at 1386) (emphasis added)*

Without printing the registration form, it is not a registration form. It is the printing, combined with separability of the registration form from the unfolded key packet, that makes the registration form a registration form.

The registration form is separated from the unfolded key packet of the claimed invention prior to folding of the key packet. That is why the registration form is separated from the unfolded key packet by a line of perforations in the currently claimed single-sheet registration form and key packet. In *Thompson*, the closure panel is not intended to be separated from the ticket envelope, and is

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remaning portion of the ticket envelope by a fold line.
ce tea h, mention, or suggest any kind of printing material
panel and does not teach or mention any kind of use of the
as an integral part of the folded ticket envelope.
f the Board and Examiner appears to be that, applying
obvious to substitute a line of perforations for a fold line.
aminor take an additional step, using the accurate and well
ght recognition, to assert that, since a line of perforations
ne, a and since a line of perforations can also be used to
together, it would be obvious to clip Thompson's closure
ticket envelope, print it with registration material, and call
owe ver, hindsight recognition is not allowed in crafting
ns. "When the art in question is relatively simple, as in
tunity to judge by hindsight is particularly tempting.
of whether to combine references needs to be applied
zak, 175 F.3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed.
ndsight invalidation of patent claims, the law requires a
ison to combine cited references. *Gambro Lundia AB v.*
11 F.3d 1573, 1578-9, 42 USPQ2d 1378, 1383 (Fed.
is not even a single mention in Thompson, Skelton, and

therefore joined to the remaining portion of the ticket envelope by a fold line. Thompson does not once teach, mention, or suggest any kind of printing material on Thompson's closure panel, and does not teach or mention any kind of use of the closure panel other than as an integral part of the folded ticket envelope.

The reasoning of the Board and Examiner appears to be that, applying Skelton, it would be obvious to substitute a line of perforations for a fold line. Then, the Board and Examiner take an additional step, using the accurate and well honed scissors of hindsight recognition, to assert that, since a line of perforations can be used as a fold line, and since a line of perforations can also be used to separably join two forms together, it would be obvious to clip Thompson's closure panel from Thompson's ticket envelope, print it with registration material, and call it a registration form. However, hindsight recognition is not allowed in crafting obviousness-type rejections. "When the art in question is relatively simple, as in the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references needs to be applied rigorously." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). To prevent hindsight invalidation of patent claims, the law requires a teaching, suggestion, or reason to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-9, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). Because there is not even a single mention in Thompson, Skelton, and

Crowell of a registration form, or any such form that can be separated from an unfolded key packet, or any other kind of blank, there is no suggestion in the cited references for clipping the closure flap from Thompson's ticket envelope and printing it with registration material. Were the covering panel to be clipped from Thompson's ticket envelope and printed as a registration form, the ticket envelope would then be missing a covering panel, and a registration form would have been generated to no purpose.

G. The Examiner Has Failed to Present a *Prima Facie* Case of Obviousness.

The Examiner has failed to present a *prima facie* case of obviousness, and the Board has failed to recognize the rather glaring deficiencies in the Examiner's stated rejections. As stated in M.P.E.P. § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* (emphasis added)

Claims 1, 11, and 16 are provided below, for convenient reference:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly

and accurately folded into a complete key packet in two or fewer steps; and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

11. A single-sheet registration form and key packet comprising:

a single sheet dimensioned to feed through a commercially available computer printer, the single sheet including

a registration form,

an unfolded key packet separated the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps, and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

16. A single-sheet registration form and key packet comprising:

a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be reliably fed through a commercially available computer laser printer, the single sheet including

a registration form,

an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be accurately folded into a complete key packet in two or fewer steps, and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

First, as discussed above in subsection A, limitations of claim 1 include the claimed registration form and key packet is rectangular. Thompson's unfolded ticket envelope is decidedly not rectangular, as discussed above in subsection A. The Board notes, on page 7 of the Decision on Appeal, "Skelton was only relied

upon by the Examiner to show the art-recognized equivalency of score lines and perforations, and thus was not relied upon to show a rectangular form." That being the case, the Examiner has failed to find a teaching or suggestion for a rectangular form and key packet in the cited references, and has therefore failed to establish a *prima facie* case for obviousness with respect to independent claim 1 and dependent claims 2-5 and 7.

Second, as discussed above in subsection B, Thompson's unfolded ticket envelope, shown in Figure 2 of Thompson, is not a single sheet. Instead, it is a manufactured article comprising a paper blank to which a glassine sheet is bonded to form a second pocket for holding baggage-claim tickets. The Examiner has failed to show a teaching or suggestion in the cited references of a single-sheet registration form and key packet, and has therefore failed to establish a *prima facie* case for obviousness with respect to any claim in the Current Application.

Third, as discussed above in subsection C, the Examiner has failed to find a teaching or suggestion for an unfolded registration form and key packet "having dimensions, a weight, a texture, and a moisture content that allows a single sheet to be reliably fed through a commercially available computer laser printer" or an unfolded single-sheet registration form and key packet that "is dimensioned to feed through a commercially available computer printer," as claimed in independent claims 16 and 11, respectively. The Examiner has failed to establish a *prima facie*

case by failing to find a teaching or suggestion for the above-quoted limitations of claims 11 and 16.

Fourth, as discussed above in subsection D, Thompson's unfolded ticket envelope cannot be accurately folded into a complete key packet in two or fewer steps. The Examiner has failed to make a *prima facie* case of obviousness by failing to find any teaching or suggestion in the cited references for an unfolded ticket envelope that can be accurately folded into a complete key packet in two or fewer steps.

Fifth, as discussed above in subsection E, Thompson does not teach, mention, or suggest a die-cut slot that may serve as a slot or slots to hold a number of keys. Neither Skelton nor Crowell teach die slots capable of holding keys. The Examiner has failed to make a *prima facie* case of obviousness by failing to find a teaching or suggestion for a die slot that may serve as a slot or slots to hold a number of keys in the cited references.

Sixth, as discussed above in subsection F, the cited references do not teach or suggest a registration form. The Examiner has failed to make a *prima facie* case of obviousness by failing to find any teaching or suggestion for a registration form in the cited references. The Board failed to even consider the "registration form" claim limitation in independent claims 1, 11, and 16.

Considering again independent claims 1, 11, and 16, it is clear that the Examiner's failure to provide a *prima facie* case of obviousness does not depend on close interpretation of ambiguous terms or arguable interpretations of one or a few claim elements. The Examiner has utterly failed to provide a *prima facie* case of obviousness by failing to find a teaching or suggestion for even a single element of independent claims 1, 11, and 16 in the cited references.

Appellant is dismayed at the carelessness demonstrated both by the Examiner and the Board in the prosecution of the Current Application and the Decision on Appeal. Cited decisions have been mischaracterized and misrepresented, a portion of a statement in the Current Application have been taken entirely out of context to suggest unwarranted conclusions, and it is manifestly clear that neither the Examiner nor the Board has carefully read either the cited references or the prosecution history. The Board has asserted, without analysis, that Thompson teaches a single-sheet form and teaches or suggests a registration form, when Thompson teaches or suggests neither. Such conclusory statements are improper. *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). Appellant has spent many tens of thousands of dollars in legal expenses and procedural fees attempting to patent his simple invention. Having shouldered this large burden in cost and time, Appellant cannot understand why the Board could

not afford the time and care to carefully read the cited references and the prosecution history.

35 U.S.C. § 102 states that a "person shall be entitled to a patent unless" any of the specific, enumerated bars to patentability has occurred. 35 U.S.C. § 103 adds obviousness to the bars to patentability enumerated 35 U.S.C. § 102. Appellant respectfully submits that it is not within the discretion of the USPTO to subjectively judge the worth of inventions, and issue patents only for those inventions that meet the USPTO's subjective standards. Although the invention claimed in the Current Application is simple, simplicity is not a bar to patentability. *Goodyear Tire & Rubber Co., Inc. et al. v. Ray-O-Vac Company*, 321 U.S. 275, 279. Appellant's simple invention deserves the same care and attention as paid by the USPTO to complex, cutting-edge technologies and to patent applications submitted by large, well-known institutions and organizations. Hopefully, the prosecution of the Current Application and the Decision on Appeal is not representative of that care and attention.

III. Issue 2

Appellant first introduced an argument for commercial success and copying by others in the First Response. (A0448-9). In the Second Office Action, the Examiner did not respond to, or address, Appellant's arguments for secondary considerations. Appellant reiterated the arguments for secondary considerations in

the Second Response. (A0420-1). In the Third Office Action, the Examiner again failed to respond to or address Appellant's arguments for secondary considerations. In the Fourth Response, Appellant reiterated arguments for commercial success and copying by others and submitted a Declaration and four exhibits in support of the argument. (A0363-5; A0372-81). In the Fifth Office Action, the Examiner finally attempted to address Appellant's arguments with regard to secondary considerations, stating that the Declaration is insufficient because "it refer[s] only to the system described in the above-referenced application and not to the individual claims of the application. Thus there is no showing that the objective evidence of non-obviousness is commensurate in scope with the claims (*See* M.P.E.P. §716)." (A0346, Fifth Office Action, page 2, lines 11-14). In the Fifth Response, the Appellant replied:

First, with regard to the 1.132 Declaration, Applicant's representative finds perplexing the Examiner's stated reasons for finding the declaration insufficient. The Examiner refers to a lack of showing that the objective evidence of non-obviousness is commensurate in scope with the claims. This statement appears to refer to Section 716.02(d) of the M.P.E.P., which deals with evidence presented to support a claim of unexpected results. This section deals with chemical inventions, in which a range of physical of some stated value, such as temperature, is claimed. In such cases, unexpected results must be shown for the entire claimed range of the state value. This would appear to be an entirely reasonable proposition but this proposition and the M.P.E.P. section in which it is put forth have absolutely nothing to do with Applicant's claimed single-sheet registration form and key packet. Applicant does not claim a range of temperature, pressure, or chemical composition. (A0296)

In the Sixth Office Action, the Examiner reiterated her finding of insufficiency of the Declaration, citing M.P.E.P. §716 (A0279), and then, beginning on line 9 of page 8 (A0285-7), the Examiner appears to have cut and pasted a portion of the M.P.E.P. into the response. The Examiner then states:

The declaration is directed to how the invention was reduced to practice and the continued diligence of the invention and not to how the claims are non-obvious over the cited references. The submitted correspondence, purchase orders, sample forms and other materials fail to distinguish the claimed invention from the references upon which the rejections are based. The provided material dates back to the summer of 1998. The references used in the rejections are patented more than one year prior to the filing of the provisional patent application (May 20, 1999). Therefore, the Examiner maintains that the declaration is insufficient to overcome the rejections of record. (A0288)

At this point, it was clear to Appellant that the Examiner had no understanding of the significance of the Declaration and exhibits, *Graham* secondary considerations, or how evidence of secondary considerations is to be evaluated and considered during prosecution. In the Resubmitted Sixth Response, Appellant again attempted to explain to the Examiner the significance of the submitted Declaration and exhibits, and the rationale of *Graham* secondary considerations with respect to obviousness-type rejections. (A0214-18). Appellant repeated this material in the Appeal Brief (A0175-80). Upon reopening prosecution, the Examiner responded, in the Eighth Office Action, as follows:

Applicant argues that the Examiner has failed to substantively consider or respond to the previous declaration. The Examiner

disagrees and asserts that the declaration was reviewed and addressed in the previous Office Action mailed October 6, 2003. Furthermore, the Examiner continues to maintain that the declaration is insufficient to overcome the rejections as set forth above. (A0162)

In the Seventh Office Action, referred to by the Examiner in the above quote, the only statement that can possibly be construed as addressing Appellant's arguments with regard to the Declaration and submitted evidence is the following statement in section 8: "Applicant's arguments with respect to claims 1-7 and 11-21 have been considered but are moot in view of the new ground(s) of rejection." (A0206).

In the Examiner's Reply Brief, dated May 18, 2005, the Examiner states:

The Examiner stated that the declaration was insufficient to overcome the rejection since it referred only to the system described in the application and did not address the individual claims. The Examiner continues to maintain that the declaration is insufficient to overcome the currently set forth rejections. Appellant stated that the declaration provided evidence of commercial success. Appellant has failed to successfully establish commercial success since Appellant failed to provide cost information associated with Appellant's product as compared to the cost of other products provided by the competitors. Appellant has merely established commercial usability not commercial success as asserted by the Appellant. Furthermore, Appellant's declaration does not address the obviousness rejections as set forth in the Office Action. Appellant's declaration addresses the commercial success of the product and does not address the patentability of the presently claimed invention. As stated above, the Appellant has failed to adequately provide evidence of commercial success. (A0130-1)

First, Appellant notes that the Examiner has provided no citations or justification for declaring the submitted evidence as evidence of "commercial usability" rather than "commercial success." Furthermore, as pointed out by the Appellant in the

Supplemental Reply Brief filed on May 18, 2005 (A0075-81), Appellant did provide cost information for both the Appellant's product and the copy products offered for sale by competitors. Thus, as late as the Reply Brief, it is manifestly clear that the Examiner had not read and carefully considered the supplied Declaration and exhibits, and still had no understanding of secondary considerations or how such information is to be used in examination.

In the Decision on Appeal, the Board states: "Regarding the Wright declaration under 37 C.F.R. §1.132 dated July 21, 2003, we find no evidence to support Appellant's arguments but only exhibits 1 through 4 showing the paper requirements for commercial printing." (A0011). Had the Board reviewed the prosecution history, the Board would have discovered that the Wright Declaration and exhibits submitted on July 21, 2003 were not directed to arguments of commercial success, but were instead provided in support of the claim limitations introduced in independent claims 11 and 16.

Finally, beginning on page 11 of the Decision on Appeal, the Board offers a variety of arguments as to why the Declaration and evidence submitted in support of Appellant's arguments for commercial success and copying by others are insufficient. These arguments are, however, incorrect. Moreover, these arguments constitute new rejections of the Declaration and evidence, and the Board provides absolutely no direction as to how Appellant, at this late stage of the process, can

possibly satisfy the mysterious standards of sufficiency that have appeared in new and unexpected forms throughout the prosecution of the Current Application.

The Board states that "information solely on numbers of units sold is insufficient to establish commercial success." (A0011). The Board states that although Appellant "states that 'I feel that my [invention as claimed] currently enjoys about 99 percent of the current market,' Declarant does not support the statement or 'feeling' with any substantive economic evidence." (A0012) However, according to M.P.E.P. §716.01(c) III, "although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration in some way as long as the opinion is not the ultimate legal conclusion at issue." The Board argues that "a 'nexus' is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight."

(A0012-13 However, as recently stated by the Federal Circuit:

Our cases make clear that "a nexus must be established between the merits of the claimed invention and evidence of commercial success before that evidence may become relevant to the issue of obviousness." Solder Removal Co. v. USITC, 582 F.2d 628, 637 (C.C.P.A. 1978). Ordinarily, this nexus may be inferred when "the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent." Demaco, 851 F.2d at 1392. (*Iron Grip Barbell Company, Inc. v. USA Sports, Inc.*, 392 F.3d 1317,1324)

Appellant has repeatedly and vigorously pointed out, including in the Resubmitted Sixth Response (A0214-18), that the Declaration and evidence are directed to sales

of, and copying of, Appellant's single-sheet registration form and key packet, exactly that single-sheet registration form and key packet which Appellant claims in the Current Application. The sales figures are sales figures for the claimed invention. Obviously, Appellant does not have the resources to mount a nationwide advertising campaign for registration forms, and none of the other reasons why a nexus requirement might be needed to distinguish commercial success of the invention from commercial success of the product in which it is used are present in this case.

In the Declaration and Exhibit B, the Appellant provided evidence that Hilton Hotels attempted to force the Appellant to remove "patent pending" from the Appellant's paper forms, the Appellant reasoning that the hotel chain attempted to do this in order to encourage competitors to copy Appellant's product and offer the copy product to the hotel chain. The Board discounts Appellant's Declaration and exhibit, and states: "Furthermore, there is no evidence that the e-mail sender was acting in any official capacity." (A0013). Is the Board suggesting that Appellant needs to furnish an official document from Hilton Hotels in which they officially state that they are attempting to strong-arm Appellant to remove patent pending notification from his product in order to be able to request bids from competitors who would then have no obstacle to copy Appellant's products? If so, does the Board consider there to be even an infinitesimal chance that Appellant

will be able to obtain such a declaration, or is this requirement simply a convenient, if arbitrary and capricious, way to deny Appellant an opportunity to demonstrate that others attempted to unfairly facilitate copying by competitors? By what rule, statute, or holding can the Board demand such documentation?

As recently stated by the Federal Circuit:

In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level, without interim need for judicial intervention. *See Dickenson v. Zurko*, 527 U.S. 150, 154 (1999) (the PTO is an agency subject to the Administrative Procedure Act). The Board's rules are in accord. *See* 37 C.F.R. §1.196(b) (when the Board relies on a new ground of rejection, it is appropriate to provide the applicant with an opportunity to respond to that ground). (*In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005))

Although Appellant could have requested a rehearing before the Board, Appellant does not understand what would constitute a sufficient declaration and evidence. Is the Appellant required to commission an independent market analysis, for example? If so, is there a list of preferred and acceptable market-analysis firms? Should Appellant commission a market analysis of the single-sheet-registration-form-and-key-pocket market, or should Appellant commission a market analysis of the printed-form market or even the ticket-envelope-and-3D-stationery market? Just what economic evidence would be needed to convince the Board? If Appellant simply removed the word "feel" from his Declaration, would the more positive sounding statement then be sufficient? With regard to copying by others,

does the Board require that Appellants furnish a signed declaration by an officer of Hilton Equipment Corporation stating that Hilton Equipment Corporation tried to unfairly force Appellant to remove the "patent pending" notice from his product in order to be able to request bids from competitors who would then be able to copy the product without any fear of legal consequences? In short, with a seemingly endless queue of new standards of insufficiency from which the Examiner and Board can choose to dismiss arguments for commercial success and copying by others, and receiving no guidance as to how the Appellant might hurdle these obstacles, or even anticipate what new obstacles will next arise, Applicant has no reasonable chance, at this late stage in the proceedings, for successfully responding to these new rejections.

The conduct of the Examiner during lengthy prosecution of the current application indicates that the Examiner has no understanding of secondary considerations, how to consider evidence offered in support of commercial success and copying, and that the Examiner did not even read the Declaration and furnished evidence. The justifications offered by the Examiner in dismissing the Declaration and evidence make no sense. Most importantly, Appellant submits that the Examiner and Board are obligated to consider the Declaration and supplied evidence with respect to whole question of obviousness, rather than simply invent reasons to dismiss the evidence. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530,

1538 (Fed. Cir. 1983); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The conduct of the Examiner and Board appears to be completely arbitrary and capricious, and an abuse of discretion.

Appellant invented the single-sheet registration form and key packet. When Appellant first began selling the single-sheet registration form and key packet, Appellant initially enjoyed 100% of the market share, since there would obviously be a lag time from when the product was introduced to when copiers were able to begin producing the product. Following successful commercialization, several competitors listed single-sheet registration form and key packets in retail brochures included in Exhibit B. Appellant declared that, in his opinion, despite their attempts to copy and sell his claimed invention, Appellant nevertheless continued to enjoy 99% of the market share. His "feeling" is based on the fact that Hilton Hotels was, at that time, by far the largest purchaser of single-sheet registration form and key packets, and that Appellant was selling to Hilton Hotels almost all of the single-sheet registration form and key packets that were being purchased by Hilton Hotels at the time. Had Hilton Hotels been successful in forcing Appellant to remove the "patent pending" label from his product, it can be speculated that the competitors may have increased their market share. The Appellant has provided sales figures showing steady, increasing sales of his claimed invention. Appellant has provided, as best as possible, his estimate of the market share that he enjoys. If

this evidence is insufficient, according to the seemingly arbitrary reasons by which the evidence is dismissed by both the Examiner and the Board, often without citation to authority, then the Examiner or Board should have provided clear direction to Appellant as to what type of evidence he needs to provide at a point in the process when Appellant would have had a reasonable chance of responding.

CONCLUSION

Prosecution of the Current Application has spanned over six years, eight Office Actions, six Responses, the Appeal Brief, the Examiner's Answer, the Supplemental Reply Brief, and ten of thousands of dollars in legal expenses and fees. During this entire time, no credible rejection based on cited references has been offered, and only in the Decision on Appeal, after more than five years, has the USPTO provided an intelligible, although unfounded, justification for rejecting Appellant's Declaration and submitted evidence in support of *Graham* secondary considerations. Appellant respectfully requests reversal of the rejections of claims 1-7 and 11-21, and, in view of the unjustifiably lengthy prosecution of the Current Application, respectfully requests that the USPTO be directed to allow claims 1-7 and 11-21 and to add 5 years extension to the term of the issued patent.

August 26, 2006
Date

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

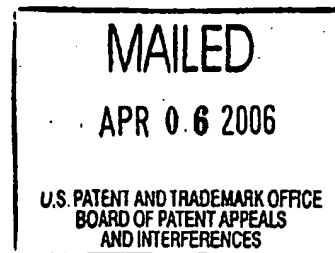
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TED EUGENE WRIGHT

Appeal No. 2006-0003
Application 09/499,069

ON BRIEF



Before OWENS, WALTZ, and KRATZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's non-final rejection of claims 1 through 5, 7, and 11 through 21. The only other claim pending in this application is claim 6, which has been objected to by the examiner as depending on a rejected claim, but has been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Answer, page 2, ¶(3), and page 8). Although the rejection appealed from was a non-final action (mailed June 4, 2004), we have jurisdiction since the claims have

been twice presented and rejected. See 35 U.S.C. § 134; *Ex parte Lemoine*, 46 USPQ2d 1420, 1422-23 (Bd. Pat. App. & Int. 1998).

According to appellant, the invention is directed to a single-sheet registration form and key packet intended for use in hotels, motels, and other such businesses in which customers are registered and provided with keys, where the clerk separates the registration form from the key packet along a line of perforations, and then assembles the key packet in two steps by folding along two lines of perforations, inserting one or more room keys into slots dye-cut into the key packet, and handing the assembled key packet to the customer (Brief, page 2).¹

Representative independent claims 1 and 11 are reproduced below:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.
11. A single-sheet registration form and key packet comprising:
 - a single sheet dimensioned to feed through a commercially available computer printer, the single sheet including
 - a registration form,
 - an unfolded key packet separated [sic, separating] the registration form by a line of perforations, the unfolded key packet including at most two lines of

¹Unless otherwise noted, we refer to and cite from the Supplemental Brief on Appeal dated Oct. 7, 2004.

perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps, and
one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

The examiner has relied upon the following evidence of obviousness:

Thompson	3,655,119	Apr. 11, 1972
Crowell	4,592,573	Jun. 03, 1986
Skelton	4,850,611	Jul. 25, 1989

Claims 1-5 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of Skelton (Answer, page 3).

Claims 11-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of Skelton and Crowell (Answer, page 5).²

Based on the totality of the record, including due consideration of appellant's Brief dated March 11, 2004, the

²The examiner, in both the Answer and the non-final rejection mailed June 4, 2004, lists "claims 11-15" as subject to this ground of rejection. However, since appellant recognizes that the examiner intended to reject claims 11-21 and argues these claims as rejected (Brief, page 2, and page 4, first paragraph), we determine that appellant had adequate notice of this rejection. Furthermore, the examiner recognizes that claims 11-21 are rejected and sets forth a separate discussion of each claim (Answer, pages 2 and 5-8; Office action mailed June 4, 2004, pages 5-7). Therefore we consider this error harmless. For purposes of this appeal, we consider this rejection to include claims 11-21.

Supplemental Brief dated Oct. 7, 2004, the Declarations and Exhibits, as well as the Answer and Office action dated June 4, 2004, we *affirm* both rejections on appeal essentially for the reasons set forth in the Answer and those reasons set forth below.

OPINION

The examiner finds that Thompson discloses a ticket envelope (10) comprising a registration form (26), an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), where the unfolded packet includes at most two score lines (30 and 36) that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps, and a die-cut slot (42) in the unfolded packet which is capable of holding any number of items (Answer, page 3). Thus the examiner finds that Thompson discloses all the claim limitations except for the score lines being perforations as required by the claims on appeal (Answer, page 4). Therefore the examiner applies Skelton for its disclosure of a similar foldable envelope to that of Thompson, where the plurality of panels are separated from each other by a perforated, embossed or scored line, with Skelton further teaching that scores and perforations are equivalent structures known in the art for folding, with

later possibilities of severing and separation (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellant's invention to use alternate creasing methods in the ticket envelope of Thompson, i.e., to substitute lines of perforations, as taught by Skelton, for the score lines disclosed by Thompson (*id.*). We agree.

Implicit in our review of the examiner's obviousness analysis is that the claim must first have been correctly construed to define the scope and meaning of any contested limitations. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997). During examination proceedings, claims are given their broadest reasonable interpretation as the terms are ordinarily used, consistent with the specification. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995). With regard to the language used in claim 1 on appeal, we construe the claim as including at least³ a rectangular, single-sheet blank

³Note the use of the transitional term "comprising" which opens the claim to additional elements. See *Genentech Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

where one portion of the blank is designated a "registration form," and that portion is separated from another portion of the blank (designated the "key packet") by a line of perforations. We further construe this claim as having this other portion of the blank including at most two lines of perforations, with the capability of being folded in two or fewer steps, and having one or more die-cut slots which are capable of serving as a slot to hold a number of keys. It is clear that the claim is directed to the "unfolded" product which merely has the *capability* of being folded to form a complete key packet and registration form, as disclosed and exemplified in appellant's Figure 2 (see claim 1 on appeal, line 3, and the specification, page 5, ll. 9-26).

Appellant argues that the ticket envelope disclosed by Thompson is "non-rectangular" while claim 1 on appeal requires a rectangular single-sheet registration form (Brief dated Mar. 11, 2004, pages 9-10; Reply Brief, unnumbered page 14). Appellant further argues that the unfolded form of Skelton is not rectangular (Brief, pages 6-7; Reply Brief, unnumbered page 14). These arguments are not persuasive. Merely changing the shape of a paper form does not render the claimed form patentable, absent some showing of criticality. See *In re Dailey*, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966). Appellant does not allege,

much less show, any criticality for the shape of the registration form.⁴ We note that independent claim 11 on appeal does not require any particular shape for the single-sheet registration form and key packet. Finally, we note that Skelton was only relied upon by the examiner to show the art-recognized equivalency of score lines and perforations, and thus was not relied upon to show a rectangular form.

Appellant argues that Thompson fails to teach, mention or suggest a rectangular, single-sheet entity of any kind, two components separable via perforations, and a key packet including at most two lines of perforations (Brief dated Mar. 11, 2004, page 12; Reply Brief, unnumbered page 16). Appellant also argues that Thompson does not disclose a key packet that would be "sufficiently stiff or properly dimensioned" for holding metallic keys or key cards (Reply Brief, unnumbered page 16).

Appellant's arguments are not persuasive. As admitted by the examiner, Thompson does not disclose or teach the use of perforations to fold the portions of the single-sheet form (Answer, page 4). However, the examiner has applied Skelton for its teaching of alternative or equivalent methods of creasing or

⁴To the contrary, appellant's specification teaches that the single-sheet registration form "may have any number of different shapes" (page 8, ll. 10-12).

folding the portions of a single-sheet form, namely the equivalence of score lines and perforations (*id.*). See *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982) ("Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious"). Appellant has not addressed the combination of prior art references *as a whole* but simply improperly argues the merits of each reference individually. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appellant provides no reasoning or support for the conclusion that the packet taught by Thompson would not be "sufficiently stiff or properly dimensioned" for holding metallic keys or key cards (Reply Brief, unnumbered page 16). See *In re Scarborough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) (generally held that attorney argument is not sufficient to replace evidence or expert testimony). We note that the slot 42 disclosed by Thompson is exemplified as holding a baggage claim ticket (52) (see Figure 1), as well as being capable of holding travel tickets (col. 1, ll. 4-6). Claim 1 on appeal merely requires that the "one or more die-cuts" must be *capable of* serving "as a slot ... to hold a number of keys," and the type of key is not recited. Appellant has not set forth any reasoning

why the slot 52 of Thompson would not be capable of holding a number of keys, whether the keys are metal or paper. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has capability of functioning in the same manner).

Appellant's argument that Thompson does not teach, mention or suggest a rectangular, single-sheet "entity of any kind" (Brief dated Mar. 11, 2004, page 12) is not well taken. The "rectangular" shape of the form has been discussed above. Thompson clearly discloses a "single-sheet" form (unitary blank 12; see Figure 2). Thompson also clearly discloses the corresponding number of score lines 30, 36 and 40 (instead of the claimed perforations), with a unitary blank where the packet (for holding baggage claim tickets or travel tickets) is capable of being folded into a complete packet in "two or fewer steps" as required by the claims on appeal (see col. 2, ll. 49-59).

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a prima facie case of obviousness in view of the reference evidence to Thompson and Skelton.

With regard to the rejection of claims 11-21, the examiner applies Thompson and Skelton as discussed above and in the Answer, and additionally applies Crowell to show the well known pre-printing of information by computer printers onto foldable sheets (Answer, page 7). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to include pre-printing of information on the envelope of Thompson, as taught by Crowell, before folding (*id.*). We also agree with the examiner's findings of fact and conclusion of law.

Appellant admits that Crowell teaches imprinting on a card or sheet before assembly but argues that Crowell does not remedy the deficiencies in Thompson and Skelton (Brief dated Mar. 11, 2004, page 13). Accordingly, we adopt our remarks and reasons from above and determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence.

Appellant presents extensive arguments concerning secondary considerations of non-obviousness, i.e., commercial success, copying by others, attempts to remove patent pending labels, and long-felt need (Brief, pages 4-5; Brief dated Mar. 11, 2004, pages 4-9; and the Reply Brief, unnumbered pages 7-13).

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Accordingly, we re-evaluate the evidence for obviousness against appellant's countervailing evidence of non-obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding the Wright Declaration under 37 CFR § 1.132 dated July 21, 2003, we find no evidence to support appellant's arguments but only Exhibits 1 through 4 showing the paper requirements for commercial printing. We determine that this evidence is not relevant to any argument of commercial success. Appellant apparently relies solely on the Wright Declaration under 37 CFR § 1.132 dated Nov. 27, 2002, with accompanying Exhibits A through D (Reply Brief, unnumbered pages 7-8). However, this evidence is not persuasive of unobviousness for the following reasons.

With regard to evidence of "commercial success," Declarant Wright states the sales figures for the years 2000, 2001 and the first five months of 2002 (Declaration, page 2). However, "information solely on numbers of units sold is insufficient to establish commercial success." *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); see also *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985). Furthermore,

Declarant Wright states that "I feel that my [invention as claimed] currently enjoys about 99% of the current market."

Declaration, page 2, underlining added. Declarant does not support this statement or "feeling" with any substantive economic evidence. See *Cable Elec. Prods.*, 770 F.2d at 1026, 226 USPQ at 888 ("Without further economic evidence, for example, it would be improper to infer that the reported sales represent a substantial share of any definable market"). For example, Exhibit A shows the order forms for two competing businesses (Focus Services and USFI) but Declarant has not specified, with concrete economic evidence, their share of the market or if other businesses have any market share (see the Reply Brief, unnumbered page 11).

Our reviewing court has also frequently held that

...for commercial success of a product embodying a claimed invention to have true relevance to the issue of nonobviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter. Thus, a 'nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight enroute to [a] conclusion on the obviousness issue.' [Case citations omitted]. *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d at 1026, 226 USPQ at 888.

From our review of the evidence of record, we fail to find the required nexus between the merits of the claimed subject matter and the evidence offered.

With regard to Exhibit B, the e-mail correspondence merely states that the term "patent pending" on appellant's paper forms appears to be contrary to the Hilton company policy. Furthermore, there is no evidence that the e-mail sender was acting in any official capacity. Finally, Declarant has not shown that this alleged attempt to remove "patent pending" from appellant's paper forms constitutes evidence of nonobviousness.

With regard to Exhibit C, we note that this Exhibit merely shows prior art forms (Declaration, pages 3-4, ¶5). Finally, Exhibit D merely shows an embodiment of the claimed invention (Declaration, page 4).

Contrary to appellant's arguments, we find no substantive evidence in this Declaration of "copying" and "long-felt need" (Reply Brief, unnumbered page 7). Declarant's statement that "I believe that Hilton Hotels Corporation took this step" in order to bid out production of the claimed form to other printers (Declaration, page 3) is mere speculation and is unsupported by evidence. Furthermore, even assuming *arguendo* that Declarant's statement is correct, there is no substantive evidence of product

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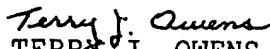
copying. See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d at 1026-27, 226 USPQ at 888-889.

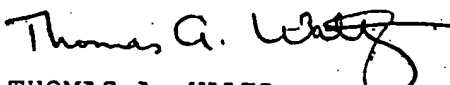
Based on the totality of the record, including due consideration of appellant's evidence and arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm both rejections on appeal.

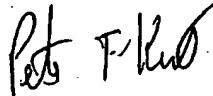
The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED


TERRY J. OWENS)
Administrative Patent Judge)


THOMAS A. WALTZ)
Administrative Patent Judge)


PETER F. KRATZ)
Administrative Patent Judge)

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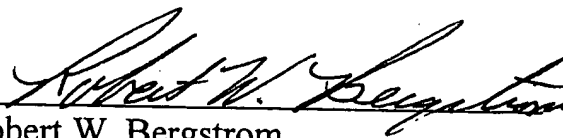
PROOF OF SERVICE

The undersigned counsel for Appellant hereby certifies that two copies of the foregoing REPLACEMENT BRIEF OF APPELLANT TED EUGENE WRIGHT were caused to be served upon counsel for Appellee, this ____ day of August 2006, in the manner indicated.

VIA EXPRESS MAIL

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571-272-9035

Pursuant to Rule of 25(d), Fed.R.App.P., because the brief is being filed by dispatch in accordance with Rule 25(a)(2)(B)(ii), Fed.R.App.P., the undersigned counsel also certified that twelve true and correct copies (including the original) of the foregoing REPLACEMENT BRIEF OF APPELLANT TED EUGENE WRIGHT were duly dispatched for filing on this ____ day of August 2006 in the manner indicated.


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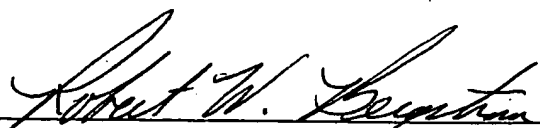
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